

Application No. 10/521,421
Amendment and Response dated February 5, 2010
Reply to Office Action of November 19, 2009
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REMARKS

Claims 1-22 are pending in this application. By this Amendment, claims 12-14 are cancelled, claims 1, 2, 8, 11, 16, 18 and 19 are amended, and new claim 22 is presented. Support for the amendments to the claims may be found, for example, in the original claims and the specification. Amendments to claims 1-3 and 8-21 were made to improve the clarity of the claims and to better conform to U.S. practice, and not for reasons relating to patentability. No new matter is added.

In view of the foregoing amendments and following remarks, reconsideration and allowance are respectfully requested.

I. Maintained Rejections under 35 U.S.C. §112, Second Paragraph

Claim 11

The Office Action has maintained a rejection of claim 11 as allegedly lacking clarity. Without conceding the propriety of the rejections, claim 11 is amended to more clearly recite various novel features of the claimed invention, with particular attention to the Examiner's comments. Specifically, claim 11 is amended to clarify that "the process of claim 1, characterized in that in step (A) the compound of the general formula (II) is reacted with Boc anhydride or Boc carbamate," thereby obviating the rejection. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Claim 16

The Office Action has maintained a rejection of claim 16 as allegedly lacking antecedent basis. In particular, the Office Action asserts that "claim 16 recites "the quinine used in Step B" of claim 1. However claim 1 makes reference only to a benzoquinone, not quinine"

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By this Amendment claim 16 is amended to clarify that “[t]he process of claim 1, characterized in that the benzoquinone used [in step (B)] is a substituted benzoquinone,” thereby obviating the rejection. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

II. Claim Objections

The Office Action objects to claim 12 for an informality. By this Amendment, claim 12 is cancelled, rendering its objection moot. Accordingly, reconsideration and withdrawal of the objection are respectfully requested.

III. Rejection under 35 U.S.C. §112, Second Paragraph

Claims 2 and 16

The Office Action rejects claims 2 and 16 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Office Action asserts that “the term ‘preferably’ renders the claims indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.” *See* Office Action, page 6, no. 4. By this Amendment, claims 2 and 16 are amended to delete the term “preferably,” thereby rendering the rejection moot.

Claim 8

The Office Action rejects claim 8 for reciting that “characterized in that R₄ is alkyloxycarbonyl, isobutyloxycarbonyl, tert-butyloxycarbonyl, tert-amyoloxycarbonyl, cyclobutyloxycarbonyl, 1-methylcyclobutyloxycarbonyl, cyclopentyloxycarbonyl, cyclohexyloxycarbonyl, and 1-methylcyclohexyloxycarbonyl.” By this Amendment, claim 8 is amended to recite that “R₄ is selected from the group consisting of isobutyloxycarbonyl, tert-

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butyloxycarbonyl, tert-amyoxy carbonyl, cyclobutyloxycarbonyl, 1-methyl-cyclobutyloxycarbonyl, cyclopentyloxycarbonyl, cyclohexyloxycarbonyl, and 1-methylcyclohexyloxycarbonyl, in accordance with the Examiner's helpful suggestion. Accordingly, reconsideration and withdrawal of the objection are respectfully requested.

Claim 12

The Office Action rejects claim 12 as allegedly lacking antecedent basis. By this Amendment, claim 12 is cancelled, thereby rendering its rejection moot.

Claim 18

The Office Action rejects claim 18 for allegedly reciting a broad range together with a narrow range that falls within the broad range. In particular, the Office Action asserts that claim 18 recites the broad recitation "an alkali metal salt, an alkaline earth metal salt, an ammonium salt," and the claim also recites a "salt of sodium, potassium or ammonium," which is the narrower statement of the range/limitation." *See* Office Action, page 8, first paragraph.

By this Amendment, claim 18 is amended to delete the recitation of "salt of sodium, potassium or ammonium," thereby rendering the rejection moot. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

IV. Rejection under 35 U.S.C. §112, First Paragraph

The Office Action rejects claims 1-21 under the enablement requirement of 35 U.S.C. §112, first paragraph. By this Amendment, claims 12-14 are cancelled, rendering the rejection moot as to those claims. As to the remaining claims, Applicant respectfully traverses the rejection.

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In particular, the Office Action asserts that the specification “does not reasonably provide enablement for all Group VIII metals as catalysts, as recited in claim 1, or for the Group VIII metal iron, ruthenium, osmium, cobalt, rhodium, iridium, nickel, palladium, and platinum, or for the Group IB metals copper, silver, and gold, as recited in claim 12.”

Without conceding the propriety of the rejections, independent claim 1 is amended to more clearly recite various novel features of the claimed invention, with particular attention to the Examiner's comments. Specifically, independent claim 1 is amended to clarify that “the compound obtained [in step (A)] is reacted in the presence (i) of a dehydrogenation catalyst is selected from the group comprising catalytically active Pd(0) compounds, the tris(dibenzylidineacetone)dipalladium-chloroform complex and Pd(II) compounds, said Pd(II) compounds being selected from the group consisting of PdCl₂, Pd(dppe)₂, [dppe = bis(1,2-biphenylphosphino)ethane], Pd(dppe)Cl₂, Pd(OAc)₂ and Pd(dppe)(OAc)₂ and from π-allyl-Pd complexes, including π-allyl-Pd chloride dimer, and mixtures thereof.” Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

V. New Claim

By this Amendment, new claim 22 is presented. New claim 22 depends from claim 1 and, thus, is free of the objection and rejections for at least the reasons discussed above with respect to claim 1. Prompt examination and allowance of new claim 22 are respectfully requested.

VI. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the application are earnestly solicited.

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Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

No fees are believed to be due with regard to this communication. The Commissioner, however, is hereby authorized to charge payment of any fees associated with this communication, or credit any overpayment, to Deposit Account No. 08-2461. Such authorization includes authorization to charge fees for extensions of time, if any, under 37 C.F.R. §1.17 and also should be treated as a constructive petition for an extension of time in this reply or any future reply pursuant to 37 C.F.R. §1.136.

Respectfully submitted,

/Julie Tabarovsky/
Julie Tabarovsky
Registration No. 60,808
Attorney for Applicants

HOFFMANN & BARON, LLP
6900 Jericho Turnpike
Syosset, New York 11791
(973) 331-1700